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Attorney Docket No. 050229-0287

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**



re the Application of

Susheng GAN, et al.

Serial No.: 09/973,945

Filed October 11, 2001

: Customer No. 20277

: Confirmation No. 5823

: Group Art Unit: 1631

: Examiner: Ardin H. Marschel

For: GENETIC INSULATOR FOR PREVENTING INFLUENCE BY ANOTHER GENE  
PROMOTER

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Restriction Requirement  
Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action [non-final] mailed September 30, 2003, having a shortened statutory period for response set to expire October 30, 2003 wherein restriction and an election of species has been required, Applicants hereby elect **Group I (claims 1-11)** with traverse, and sequence species **SEQ ID NO. 9** with traverse, for prosecution in the above-identified application.

**REMARKS**

Claims 1 -17 are pending. The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121.

Group I, claims 1-11, drawn to an isolated polynucleotide, classified in class 536, subclass 23.1. If this Group is elected, then the below summarized sequence election is required.

Group II, claims 12-14, drawn to a method for expressing a polypeptide, classified in class 435, subclass 455. If this Group is elected, then the below summarized sequence election is required.

Group III, claims 15 and 16, drawn to a method of making a recombinant plant cell, classified in class 800, subclass 13. If this Group is elected, then the below summarized sequence election is required.

Group IV, claim 17, drawn to a method for insulating the expression of a transgenic polypeptide, classified in class 435, subclass 455. If this Group is elected, then the below summarized sequence election is required.

Applicants respectfully traverse the restriction requirement on the grounds that a restriction requirement between patentably distinct inventions is proper only when there is a serious burden on the Patent Office to examine all of the claims in a single application even when it appears that appropriate reasons exist for a restriction requirement. M.P.E.P. § 803. To avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, Applicant respectfully request that above policy be applied in the present application because the subject matter of the pending claims is sufficiently related.

For instance, Group I is directed to a polynucleotide having the sequence set forth in SEQ ID NO. 9, such polynucleotide inserted into a vector, such polynucleotide inserted into a vector situated in a host cell, and such polynucleotide inserted into a vector situated in a host cell situated in a plant. Group II is directed to a method of expressing a polypeptide using a vector inserted with the polynucleotide of Group I (i.e., having a sequence set forth in SEQ ID NO. 9). Group II is directed to a method of making a recombinant plant cell by providing the polynucleotide of Group I. Group III is directed to a method of insulating the expression of a transgenic polypeptide by transfecting a plant cell with a polypeptide comprising the polynucleotide of Group I. It is respectfully submitted that the pending claims are sufficiently related by a polynucleotide having the sequence set forth in SEQ ID NO. 9.

The Examiner has also required election of species to a single amino acid/polypeptide sequence if an elected group is drawn to an amino acid/polypeptide sequence, or to a single nucleic sequence for an elected group drawn to nucleotide sequences.

Applicants respectfully traverse the election on the grounds that the various amino acid/polypeptide and nucleic acid species referred to in the official action are simply different embodiments of the same invention. Applicants have presented a generic invention with a generic claim and set forth a number of embodiments falling within the generic invention. It is respectfully submitted that all of these embodiments should be examined in a single application.

Notwithstanding the foregoing, Applicants respectfully submit that if claims reciting the elected species are found to be allowable, then claims containing all of the disclosed species should be allowable as well.

Applicants respectfully request reconsideration and withdrawal of the restriction and election requirements and request prosecution of the application in its entirety. However, in response to the requirement, Applicants specifically reserve the right to file divisional applications drawn to the non-elected subject matter.

### CONCLUSION

For these reasons, Applicants submit that the restriction and election requirement are improper and should be reconsidered and withdrawn. Favorable action on all claims is respectfully requested.

To the extent necessary, please charge any shortage in fees due, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Date: October 30, 2003

Respectfully submitted,  
MCDERMOTT, WILL & EMERY



Kelli N. Watson  
Registration No. 47,170

McDermott, Will & Emery  
600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Telephone: (202) 756-8351  
Facsimile: (202) 756-8087